

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s):	Wade Thomas Cathey, Jr.	Confirmation No.:	6369
Serial No.:	10/758,740	Group No.:	2872
Filed:	January 16, 2004	Examiner:	Audrey Y. Chang
For:	Extended Depth of Field Optical Systems		

Mail Stop Issue Fee
Commissioner For Patents
P.O. Box 1450
Alexandria, VA 22313-1450

COMMENTS ON STATEMENT OF REASONS FOR ALLOWANCE

Sir:

The Examiner has cited reasons for allowance in this application in connection with the Notice of Allowance mailed May 30, 2008. It appears the Examiner's reasons for allowance do not recite the exact language of the claims. We wish to point out that the exact language of these claims is the best recitation supporting the reasons for allowance. Further, Applicants wish to point out that there are additional reasons for allowance, including features of independent and dependent claims not specifically referenced in the Notice of Allowance.

We also note that the Notice of Allowability included the following statement with respect to material considered in the parent application (U.S. Patent Application No. 09/070,969, now U.S. Patent 7,218,448), of which the present application is a continuation: "The IDS filed in the parent application have been considered by the examiner while examining the prior application." Also, no copy of the IDSs from the parent application were initialed and entered into the record of the present application.

We point out that certain Examiner responsibilities regarding consideration of material submitted in Information Disclosure Statements are specifically defined in the MPEP:

“Consideration by the examiner of the information submitted in an IDS means nothing more than considering the documents in the same manner as other documents in Office search files are considered by the examiner while conducting a search of the prior art in a proper field of search. The initials of the examiner placed adjacent to the citations on the PTO/SB/08A and 08B or its equivalent mean that the information has been considered by the examiner to the extent noted above.” §609, emphasis added.

“The examiner will consider information which has been considered by the Office in a parent application when examining: (A) a continuation application filed under **37 CFR 1.53(b)**, (B) a divisional application filed under **37 CFR 1.53(b)**, or (C) a continuation-in-part application filed under **37 CFR 1.53(b)**.” §609.02(A)(2).

“If the application under examination is identified as a continuation, divisional, or continuation-in-part of an earlier application, the examiner will consider the prior art cited in the earlier application. See MPEP § 609. The examiner must indicate in the first Office action whether the prior art in a related earlier application has been reviewed.” §2001.06(b).

We believe these passages from the MPEP clarify (1) that the Examiner’s responsibility to consider information cited in parent applications includes considering patentability of the claims of the subject application in light of such information, not simply considering such information “while examining the prior application,” and (2) that such consideration is most properly documented by a copy of the IDSs from the parent application entered into the subject application with the Examiner’s initials signifying such consideration.

“The presumption of validity is generally strong when prior art was before and considered by the Office and weak when it was not.” See *Bolkcom v. Carborundum Co.*, 523 F.2d 492, 498, 186 USPQ 466, 471 (6th Cir. 1975). Applicants have complied with Duty of Disclosure in the present case and are entitled to the “strong” presumption of validity conferred by consideration of the information cited.

Therefore, in light of the Examiner's remark that the information cited was "considered by the examiner while examining the prior application," and yet the Examiner failed to enter an initialed copy of the IDSs in the present application, and in order to clarify the record of the present application, Applicants assert for the record that the Examiner apparently agrees that the claims of the present application are patentable over the information cited in U.S. Patent Application No. 09/070,969. A lack of response by the Examiner to these remarks will serve to signify the Examiner's agreement with Applicants' assertion.


Since the present application has passed to the Publishing Division, a copy of these Comments is being sent to the direct attention of the Examiner.

Respectfully submitted,

LATHROP & GAGE L.C.

2 September 2008

By:


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